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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/397,967	09/17/99	IHLE	J 0656.0370004

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EXAMINER

NGUYEN, Q

ART UNIT

PAPER NUMBER

1632

3

DATE MAILED:

11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/397,967	Applicant(s) IHLE ET AL	
	Examiner Quang Nguyen, Ph.D.	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 25, 26, 28-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 25, 26, 28-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 26, 28-31, 35-43, and 45-52, drawn to an isolated DNA sequence encoding a Jak kinase, an expression vector comprising the same DNA sequence and an isolated host cell comprising the same expression vector, classified in class 435, subclasses 320.1, 455; class 536 subclass 23.1, for examples.
- II. Claims 32-34 and 44, drawn to a transgenic non-human animal comprising a recombinant DNA molecule encoding a Jak kinase, classified in class 800, subclasses 13, 18.
- III. Claim 25, drawn to a Jak kinase antibody, classified in class 530, subclass 387.9.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are drawn to distinct and independent products capable of separate uses. The isolated DNA sequence of Invention I can be used as a probe in hybridization assays whereas the transgenic non-human animal of Invention II can be used for an *in vivo* screening method identifying agents inhibiting the biological responses of a eukaryotic cell to a cytokine whose activity is mediated by the activation of a Jak kinase.

Inventions I and III are drawn to mutually exclusive and independent products. The isolated DNA sequence of Invention I is composed of nucleotides whereas the antibody of Invention III is composed of amino acids. The polynucleotide is not required for the antibody and the antibody is not required for the polynucleotide.

Inventions II and III are drawn to distinct and independent products capable of separate uses. The transgenic non-human animal of Invention II can be used for an *in vivo* screening method identifying agents inhibiting the biological responses of a eukaryotic cell to a cytokine whose activity is mediated by the activation of a Jak kinase, whereas the antibody of Invention III can be used in the purification or detection of a Jak kinase protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Lawrence B. Bugaisky on September 14, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, J.D., may be reached at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2801.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1632.

Papers related to this application may be submitted to Group 160 by facsimile transmission. Papers should be faxed to Group 160 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 305-3014 or (703) 308-4242.


KAREN M. HAUDA
SUPERVISORY PATENT EXAMINER
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